

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Re: Patent Application for Nyhus Dated: March 4, 2004
Serial No.: 09/811048 Art Unit: 1638
Filed: March 15, 2001 Examiner: Ashwin Mehta
For: Inbred Corn Line G4901 Action: AFTER FINAL RESPONSE

OFFICIAL

To: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Please enter and make the amendments to the specification and claims as attached hereto.

In the Specification:

In the Specification on page 18, line 10, please delete "#8".

Remarks

This is in response to the office action dated 12/19/2003, which was final. The examiner has indicated that claims 1-5 and claim 20 are allowable as written. The applicant believes that claim one is in better form as it is now amended; claim 2 has been amended to include its parts. This amendment does not appear to change the scope of the protection. And claim three has been amended to insert a comma that was missing between ovule and anther. Claim 20 has been amended to delete "the". This amendment does not alter the scope of the claim it only acts to place it in better form for allowance. The newly added claims are believed to find full support in the specification and are believed allowable as written. The applicant has added these claims as most were indicated as allowable in other cases. The newly added claims are not believed to require any additional costs. However, if there are additional costs for any claims or an extensions of time is needed the cost should be withdrawn from Account No. 07-0190.

Claim Objections

The Examiner objected to claims 13, 14, 15, and 17 under 37 CFR §1.75 (C) as having improper form because a multiple dependent claim should refer to other claims in the alternative only. The claims have been deleted. And replaced by similar claims

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directed to the method of making the maize inbred with a desired trait (see claim 18 and claim 31 for the altered starches) and a method of making a maize plant with a transgene that confers at least one selected resistance (see claim 12). The examiner indicated in the office action that inserting amylose extender instead of ae was new matter. The Applicant's attorney is supplying 4 pages of article (three articles in total) one of the articles is dated 1997 to show that ae and amylose extender are the same thing and that the ordinarily skilled person in the art of corn breeding would know that AE is a mutated gene that is referred to as amylose extender. The Applicant's attorney offered to provide the Examiner with an affidavit to this effect but the Examiner indicated that it was not necessary if the articles showed ae was in use.

Therefore, all of the objections the examiner had to the claims should now be removed.

Claim Rejections – 35 USC §112

The examiner found that the claim language in 12 and 15 was indefinite as the plant of claim 2 was not transgenic. Claim 12 has been amended in accordance with language that the office appears to find clearer. The office has allowed similarly written claims but they were not written in the Markush style. It is believed that claim 12 as amended should be allowed. If the Examiner feels that the claim should be written as separate claims and not in the Markush style the applicant would appreciate a phone call to that effect. However, the metes and bounds of claim 12 is now believed to be clear

Deposit Requirement

The examiner has agreed to hold the deposit requirement in abeyance. When the client has made a decision to pay the issue fee based on allowable claims, then the Applicant will deposit seed.

Written description

Claim 12 as amended is believed allowable as now written.

There is sufficient written description for the removed claims in the Applicant's attorney's opinion. Still in an effort to further this prosecution, the applicant's attorney has deleted claims 6-11 and 13-17 and amended claim 12 and claim 18 to clearly stay

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within the parameters of what the examiner considers adequately described subject matter. Thus the remaining claim 12 and 18 as now written should be allowable as written.

The applicant would like it clear on the record that claims that were amended or cancelled were not necessarily amended or cancelled in a manner that would suggest that the claims are not allowable.

The applicant's attorney kindly requests that the examiner reconsider the claims as now amended and grant allowance of these claims.

Respectfully submitted,



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6 DISEASE RESISTANCE IN INBRED G4901

Eye Spot = 5.1

Gross wilt = 4

Northern leaf blight = 1.0

5 #7 INSECT RESISTANCE IN INBRED

ECB1 = 6.75

ECB2 = 4.76119

Ear rate = 3.50000

10 **#8** The comparable inbred to G4901 is ZS01595, an inbred having a number of similarities. ZS01595 is an inbred which has been or is presently in a number of commercial hybrids that are in a similar region of adaption as most of the hybrids formed with G4901.

15 The Munsell code is a reference book of color, which is known and used in the industry and by persons with ordinary skill in the art of plant breeding.

The purity and homozygosity of inbred G4901 is constantly being tracked using isozyme genotypes as shown in Table 2.

20 Isozyme Genotypes for G4901

Isozyme data were generated for inbred corn line G4901 according to procedures known and published in the art. The data in Table 2 gives the electrophoresis data on G4901 as compared to its two parents.

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CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.6

I hereby certify that the foregoing RESPONSE AFTER FINAL OFFICE ACTION(three pages of claims 1-31, one of specification and the response (4 pages) and the 4 pages of articles on "ae" of 12/19/03 for application 09/811,048 is faxed to 703-872-9306 at Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of March 2004.

